

RECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEB 22 2006

Applicant:	Hill	Conf. No.:	5158
Serial No.:	09/966,247	Art Unit:	3639
Filing Date:	09/28/2001	Examiner:	Smith, Traci L.
Title:	METHOD AND SYSTEM FOR ROUTING HARDCOPY MAIL	Docket No.:	END920010029US1 (IBME-0021)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant respectfully requests a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicant submits that the above-identified application is not in condition for appeal because the Office has failed to establish a *prima facie* case of anticipation based on an error in facts. Claims 1-34 are pending in this application.

Turning to the rejection, in the Final Office Action, claims 1-34 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Baker *et al.* (U.S. Patent No. 5,422,821), hereafter "Baker."

Applicant submits that the 35 U.S.C. §102(b) rejection of claim 1 over Baker is clearly not proper and without basis because at least one feature of the claimed invention is not taught by the reference. As argued in the Request for Reconsideration of January 18, 2006, Baker fails to teach affixing an identifier associated with a mailing address, that comprises all information necessary for routing the hardcopy mail to a location of the recipient, to a piece of hardcopy mail in lieu of

09/966,247

Page 1 of 3

the mailing address. Final Office Action, pages 9-10. In contrast, the operator in Baker reads the address from a piece of mail, supplies information from the address to the system, and the system may print a barcode on the piece of mail. As such, the barcode of Baker is not in lieu of the address, but rather is in addition to the address.

The Office responds in its Advisory Action by noting that "...applicant's specification does not preclude the address to be placed on the envelope along with the barcode." Advisory Action, page 3. The Office then admits that in one embodiment the address "...need not be displayed," i.e., that the barcode may be in lieu of the address. However, the Office chooses to read an alternative embodiment, in which the address can be included, into the claim. Applicant submits that while the claims must be read in light of the specification, limitations from the specification, such as the alternate embodiment cited by the Office, cannot be read into the claims. Furthermore, the Office's statement that "...applicant's specification does not preclude the address to be placed on the envelope along with the barcode" improperly shifts the burden of proof to require that Applicant prove that no embodiment of the claimed invention has the ability to perform the function of the cited reference. As such, the rationale that the Office uses as justification for its rejection is without legal basis.

Accordingly, Applicant submits that the Office has failed to state a *prima facie* case of anticipation and that this application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution.

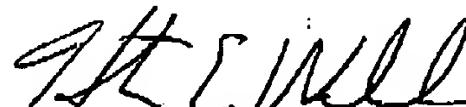
With respect to the rejections of independent claims 8, 16, 20, 28 and 33, Applicant notes that each claim includes at least one feature similar to claim 1. Further, the Office relies on the same arguments and interpretations of Baker as discussed above with respect to claim 1. To this

extent, Applicant herein incorporates the arguments presented above with respect to claim 1, and respectfully requests withdrawal of the rejections of these claims for the above-stated reasons.

With respect to features in the dependent claims not specifically referenced herein, the dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

Applicant respectfully submits that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Hunter E. Webb
Reg. No.: 54,593

Date: February 22, 2006

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

RAD/hew

09/966,247

Page 3 of 3